

REMARKS

In view of the foregoing amendments and following remarks, reconsideration and allowance of this application are requested. Claims 1-11, 13-16, 31-50, 63-66, and 100-109 are pending, with claims 1, 10, and 100 being independent. Claims 1, 10, 63-66, and 100 have been amended by this reply to even more clearly point out the claimed subject matter. Claims 101-109 have been added.

Withdrawal of Final Rejection

Applicant requests withdrawal of the final rejection. Each rejection of claims 1-11, 13-16, 31-50, 63-66, and 100 relies at least in part upon Robotham (U.S. Patent No. 6,084,590). As discussed below with respect to claims 1-11, 13-16, 31-50, 63-66, and 100, Robotham is not prior art under 35 U.S.C. § 102 and § 103. Moreover, as discussed below at lines 3-14 of page 12 of this amendment, the Office Action does not appear to address each limitation of claim 1. Therefore, Applicant respectfully requests the Examiner to withdraw the finality of the rejection.

35 U.S.C. § 103(a) Robotham Rejection

Claims 1-3, 9-11, 14, 63-66, and 100 were rejected as being obvious over Robotham (U.S. Patent No. 6,084,590). Applicant submits that Robotham is not prior art under 35 U.S.C. § 102, and thus not properly relied upon under 35 U.S.C. § 103. Consequently, Applicant requests withdrawal of these rejections. Applicant submits that the rejection of claims 1-3, 9-11, 14, 63-66, and 100 are overcome by the submission of the.

More particularly, as established by the attached Declaration under 37 C.F.R. §1.131 of inventor David Corboy, the inventions recited in claims 1-3, 9-11, 14, 63-66, and 100 were conceived and reduced to practice prior to April 7, 1997, which is the priority date of the Robotham patent. Therefore, Robotham does not qualify as statutory prior art under § 102(e), or any other provision of § 102. As such, Robotham cannot be applied in support of a § 103

rejection of claims 1-3, 9-11, 14, 63-66, and 100. It is respectfully requested that the rejection of claims 1-3, 9-11, 14, 63-66, and 100 be withdrawn.

Moreover, as acknowledged by the Examiner's Action at page 4 of the action, Robotham "does not explicitly disclose the rendering process is unaffected by an input of the recipient and the ordered display being independent of a bandwidth of a communication channel used to send the multimedia document," a limitation recited by the examined version of claim 1. The Office Action, apparently expressing a contention of official notice, states that it would have been obvious to have modified Robotham to provide an ordered display that is independent of channel bandwidth. This contention is unsupported and it seems to contradict statements made in the background of the instant patent application, which suggests that the temporal order of presentation could change from recipient-to-recipient based on channel bandwidth. For example, the discussion from page 2, line 8 to page 3, line 20 of the specification, supports the assertion that HTML web pages were downloaded and/or rendered differently depending upon the web site or the recipient.

35 U.S.C. § 103(a) Robotham / Shaw Rejection

Claims 4, 13, 15, and 16 were rejected as being obvious over Robotham in view of Shaw et al., Microsoft Office 6-in-1, Que Corporation, 1994 ("Shaw"). As established by the Declaration, the inventions recited by claims 4, 13, 15, and 16 also were conceived and reduced to practice prior to the April 7, 1997 priority date of Robotham. As such, Robotham is not statutory prior art as to the features of claims 4, 13, 15, and 16. Furthermore, as indicated above, Robotham is not statutory prior art as to claims 1 and 10 upon which claims 4, 13, 15, and 16 depend. Inasmuch as Robotham does not qualify as prior art, the proposed combination of Robotham with Shaw provides an improper basis for a rejection of claims 4, 13, 15, and 16 under §103. Consequently, it is respectfully requested that the rejection of claims 4, 13, 15, and 16 be withdrawn.

35 U.S.C. § 103(a) Robotham / Johnson Rejection

Claims 5-6 were rejected as being obvious over Robotham in view of U.S. Patent No. 5,892,847 to Johnson ("Johnson"). As established by the Declaration, the inventions recited by claims 5-6 also were conceived and reduced to practice prior to the April 7, 1997 priority date of Robotham. As such, Robotham is not statutory prior art as to the features of claims 5-6. Furthermore, as indicated above, Robotham is not statutory prior art as to claim 1 upon which claims 5-6 depend. Inasmuch as Robotham does not qualify as prior art, the proposed combination of Robotham with Johnson provides an improper basis for a rejection of claims 5-6 under §103. Consequently, it is respectfully requested that the rejection of claims 5-6 be withdrawn.

35 U.S.C. § 103(a) Robotham / Ando Rejection

Claims 7-8 were rejected as being obvious over Robotham in view of U.S. Patent No. 5,600,826 to Ando ("Ando"). As established by the Declaration, the inventions recited by claims 7-8 also were conceived and reduced to practice prior to the April 7, 1997 priority date of Robotham. As such, Robotham is not statutory prior art as to the features of claims 7-8. Furthermore, as indicated above, Robotham is not statutory prior art as to claim 1 upon which claims 7-8 depend. Inasmuch as Robotham does not qualify as prior art, the proposed combination of Robotham with Ando provides an improper basis for a rejection of claims 7-8 under §103. Consequently, it is respectfully requested that the rejection of claims 7-8 be withdrawn.

35 U.S.C. § 103(a) Robotham / Caire et al. Rejection

Claims 31-50 were rejected as being obvious over Robotham in view of U.S. Patent No. 5,663,962 ("Caire"). As established by the Declaration, the inventions recited by claims 31-50 also were conceived and reduced to practice prior to the April 7, 1997 priority date of Robotham. As such, Robotham is not statutory prior art as to the features of claims 31-50. Furthermore, as indicated above, Robotham is not statutory prior art as to claims 1 and 10 upon which claims 31-

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50 depend. Inasmuch as Robotham does not qualify as prior art, the proposed combination of Robotham with Caire provides an improper basis for a rejection of claims 31-50 under §103. Consequently, it is respectfully requested that the rejection of claims 31-50 be withdrawn.


Request for Copy of Form PTO-892

Applicants request a copy of the Form PTO-892 that was indicated to have been attached to the Office Action mailed January 21, 2004.

No fee is believed to be due. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

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